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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,826	03/09/2004	Yuichiro Itakura	JCLA21100	2452
23900	7590	12/18/2007		
J C PATENTS, INC. 4 VENTURE, SUITE 250 IRVINE, CA 92618			EXAMINER DUNHAM, JASON B	
			ART UNIT 3625	PAPER NUMBER
			MAIL DATE 12/18/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/796,826	<b>Applicant(s)</b> ITAKURA ET AL.	
	<b>Examiner</b> Jason B. Dunham	<b>Art Unit</b> 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/20/06</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

Applicant amended claims 1, 3, 7, 10-11, 13, and 15 and added claims 17-18 in the response filed April 30, 2007 in reply to the office action dated July 17, 2006.

### *Priority*

Acknowledgment is made of applicant's claim for foreign priority based on application H8-163679 filed in Japan on June 5, 1996. It is noted, however, that applicant has not filed a certified copy in this United States application of the Japanese application as required by 35 U.S.C. 119(b).

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by  
Rose (US 5,757,917).**

Referring to claim 1. Rose discloses a terminal having a browser for communicating with the web, comprising:

- A message viewer for communicating with a private network without using said World Wide Web (Rose: abstract & column 3, lines 51-67 and column 11, line 64 – column 12, line 29. The examiner notes that column 12 of Rose discloses a message system on a "below the line" or private network); and
- A communication means through which said browser communicates with said web and said message viewer communicates with said private network using different logical links (Rose abstract, figure 2, and column 3, line 51 – column 4, line 15), wherein;
- Said browser includes means for ordering goods from a host computer connected to said web, means for receiving a bill for said goods from said web, and means for transmitting said bill to said message viewer (Rose: figures 5 and 6a-6f), and
- Said message viewer includes means for paying said bill through said private network (Rose: abstract).

Referring to claim 2. Rose further discloses an apparatus, wherein said message viewer includes:

- Means for receiving information indicative of payment completion from said private network (Rose: abstract); and
- Means for transmitting said information indicative of payment completion to said browser (Rose: figure 5), and
- Said browser includes means for notifying said payment completion to said host computer through said web (Rose: figure 5).

Referring to claim 3. Rose discloses an apparatus as discussed above in the rejection to claim 1 and further discloses an apparatus wherein:

- Said message viewer includes means for ordering goods through said private network, means for receiving a bill for said goods from said private network, payment means for paying said bill through said private network, and means for transmitting information that said order and said payment have been completed to said browser (Rose: column 9, line 65 – column 10, line 13); and
- Said browser notifies said completion of said order and said payment to said web (Rose: figure 6f).

Referring to claim 4. Rose further discloses an apparatus wherein payment means of said message viewer transmits a credit card number and an expiration date of a user of said terminal to said private network (Rose: figure 1).

Referring to claim 5. Rose further discloses an information provider having a gateway through which a terminal accesses web, and a connection manager which manages a communication through said gateway, comprising:

- A message manager which communicates with said terminal independently from said gateway, wherein:
  - Said gateway includes means for transmitting said goods order input through said terminal to a host computer connected to said web; and means for transmitting a price information of said goods from said host computer through said web to said terminal (Rose: column 7, lines 48 – 67). The examiner notes that a gateway is a device for connecting

networks using different communications protocols so that information can be passed from one to the other. Rose discloses using an interactive protocol to contact the seller's address to transmit price information.

- o Said message manager is connected to a payment system which enables payments through a private line, and said message manager includes means for receiving said price information from said terminal, and request means for requesting through said private line said payment system to pay an amount indicated by said price information (Rose: column 9, line 65 – column 10, line 13).

Referring to claims 6-9. Claims 6-9 are rejected under the same rationale set forth above.

Referring to claim 10. Rose further discloses a system for paying for goods ordered through the web by a user of a terminal accessing said web, said system comprising:

- A user database for storing a credit card number and an expiration date of a credit card owned by said user (Rose: figure 1);
- An interface for connecting to a closed network which executes a payment by a credit card (Rose: figure 1);
- Means for communicating with said terminal using a private network without using said World Wide Web, which is logically independent from a communication established between said web and said terminal (Rose: column 3, line 51 – column 4, line 15 and column 11, line 64 – column 12, line 29);

- Means for receiving information indicative of a paying request an amount of payment and a store dealing in said goods from said terminal through said private network (Rose: column 3, lines 39 – 50);
- Means for reading said credit card number and said expiration date from said user database (Rose: figure 1);
- Means for transmitting said information indicative of said amount of payment and said store dealing in said goods, together with said credit card number and said expiration date to said private network (Rose: figure 5); and
- Means for receiving information indicative of that said credit card has been verified (Rose: column 6, lines 15 – 37).

Referring to claim 11. Claim 11 is rejected under the same rationale set forth in the rejection to claim 10.

Referring to claim 12. Rose further discloses a system comprising:

- A store database for storing a store name, which deals in goods, in association with said connection address of said host computer of said store (Rose: figure 9 and claim 13);
- Means for reading out said connection address of said host computer, which is identified by said store name, from said database (Rose: column 7, lines 48-67);
- Means for connecting to said host computer using said connection address through said private line (Rose: column 4, lines 1-15); and

- Means for notifying said host computer of said information indicative of that said credit card has been verified through said private line (Rose: column 6, lines 15 – 37).

Referring to claims 13-16. Claims 13-16 are rejected under the same rationale set forth above. Rose discloses mediums according to claims 13-16.

Referring to claims 17-18. Claims 17-18 are rejected under the same rationale set forth above in the rejection of claims 1-2 and 5.

### ***Response to Arguments***

Applicant's arguments filed April 30, 2007 have been fully considered but they are not persuasive. Regarding applicant's argument concerning the location of the message viewer, the applicant is reminded that if the prior art structure is capable of performing the intended use, then it meets the claim. Applicant is directed towards figure 8 and column 10, lines 42-61 of Rose disclosing communication (i.e. a message) regarding a transaction to the seller's agent. Claim 13 is rejected under this same rationale.

Applicant further argues that Rose does not disclose "a communication means through which said browser communicates with said web and said message viewer communicates with said private network using different logical links." The examiner can not find any particular definition for "logical links" within the applicant's disclosure; therefore "logical links" is given its broadest reasonable meaning. Rose clearly discloses the use of communication links in the private "below the line" network for



message viewing (see at least figure 2 and column 4, lines 1 - 15). Claim 10 is rejected under this same rationale.

The examiner disagrees with applicant's contention that Rose does not disclose the message viewer include means for transmitting the information indicative of a payment completion to the browser. Figure 9 discloses notification of payment completion originating in the below the line aspect of the payment system and then proceeding to the browser through the above the line system. Both the below and above the line systems are contained within the payment system, the "line" is a delineation between the private and public networks. Applicant's claims require payment information to be transmitted between the private message viewer and the public browser, therefore the examiner submits that Rose does anticipate the limitations of claim 2.

Applicant's arguments regarding claim 5 are also unpersuasive. In response to applicant's arguments, the recitation "information provider" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Furthermore, figure 1 of Rose discloses dedicated communication links (i.e. gateways) for accessing the web.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason B. Dunham whose telephone number is 571-272-8109. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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JBD  
Patent Examiner  
12/11/07



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